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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/679,331

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Pierre Deslongchamps

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6557

7590

08/11/2006

Darby & Darby PC  
805 Third Avenue  
New York, NY 10022

EXAMINER

EPPERSON, JON D

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,331

Applicant(s)

DESLONGCHAMPS ET AL.

Examiner

Jon D. Epperson

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/14/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination (RCE)***

1. A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under Ex Parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 6/14/06 has been entered.

### ***Status of claims***

2. Claims 34-36 were pending (e.g., see 3/15/06 Office Action). No claims were added, canceled or amended. Therefore, claims 34-36 are still currently pending and examined on the merits. All previous indications of allowability are hereby withdrawn in view of the newly cited rejections below.

### ***IDS***

3. The references listed on applicant's PTO-1449 form have been considered by the Examiner. A copy of the form is attached to this Office Action (e.g., 6/14/06 IDS).

### **New Rejections**

#### ***Claims Rejections - 35 U.S.C. 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 35 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

A. Claim 35 was added in the 11/3/03 amendment and subsequently amended in the 5/16/05 amendment. However, the Examiner cannot find support for the specific listing of currently claimed protecting groups. Specifically, the Examiner does not find support for the currently claimed protecting groups wherein said groups are bound to the N/O atoms of A<sub>1</sub>-A<sub>3</sub> via any of the recited atoms in said protecting groups (e.g., see 35 U.S.C. § 112, second paragraph rejection below). If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP 714.02.

***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. For **claim 35**, the listing of protecting groups is vague and indefinite because it is not clear (i.e., the claim provide no indication) which of the atoms are bound to the N/O atoms of the A<sub>1</sub>-A<sub>3</sub> portions of the macrocyclic compound. For example, Applicants state that C<sub>6</sub>H<sub>5</sub>-CH<sub>2</sub>-CH<sub>3</sub> is a protecting group (e.g., see claim 35, 4<sup>th</sup> listing in the Markush group). Does this mean that the N/O can be connected to the ring, the CH<sub>2</sub> group or to the CH<sub>3</sub> or, alternatively, does the last "CH<sub>3</sub>" not really represent a "CH<sub>3</sub>" at all but, rather, the position of attachment (i.e., the N/O atom). That is, the positions of attachment are not clearly marked (e.g., compare to the "T" groups in claim 34; see also 3/15/06 Examiner's amendment wherein Applicants state that (N) is the nitrogen atom of A<sub>1</sub> and (C) is the carbonyl carbon of A<sub>3</sub> thus properly defining the points of attachment). Applicants are requested to clarify and/or correct. Therefore, claim 35 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph.

B. For **claim 34**, the term "Fragment T" in the phrase "Fragment T is a radical selected from the group consisting of:" is vague and indefinite because it is not clear whether Applicants are referring to the "T" in the macrocyclic compound of formula (1) or some portion (i.e., fragment) of T. The Examiner recommends deleting the word "fragment" for correction (e.g., 3/15/06 Examiner's amendment showing similar corrections for A<sub>1</sub>, A<sub>2</sub>, and A<sub>3</sub>). Therefore, claims 34 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.

August 1, 2006

JON EPPERSON, PH.D.  
PATENT EXAMINER

